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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,037	10/28/2003	Koji Kada	NANP114US	5694

23623 7590 01/25/2005

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EXAMINER

BRUNSMAN, DAVID M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,037

Applicant(s)

KADA ET AL.

Examiner

David M Brunsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20040112.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 is directed to a coating liquid containing "metal salt according to claim 4" while claim 4 is a method claim. Examiner suggests amending claim 19 to read "metal salt produced according to the method of claim 4".

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4235794.

Example 1 of the reference teaches a process of making a organic acid metal salt by reacting plain(100%) calcium hydroxide and plain capric (saturated linear C₁₀) acid in water in a molar ratio of 1:2. The solvent is removed a ambient temperature (See column 4, lines 29-31). The difference between the prior art and the instant claims is the metal in the hydroxide employed in the example. Column 3, lines 37-38, of the reference teach magnesium and calcium function equivalently in the process. It would have been obvious to one of ordinary skill in the art to employ magnesium hydroxide to form an organic acid magnesium salt because the reference teaches the interchangeability of magnesium and calcium in the process. The similar compounds produced would be expected to exhibit similar properties such as the ethanol solubility recited in instant claim 3.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 10-14 and 17-20 rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Laid-Open Patent Publication 9-95627.

The reference teaches the compounds such as caproic, caprylic, capric, octylic and heptanoic acid magnesium salts *per se* and 2% solutions thereof in a polyhydric alcohol compound solvent that may further include butyl acetate, for example. (Both of which boil between 70 and 200 C) While the reference does not set forth the manner in which the compounds are synthesized, a product-by-process claim is anticipated by a disclosure of the product itself. The similar compounds produced would be expected to exhibit similar properties such as the ethanol solubility recited in instant claim 3.

Claims 1-7, 9, 15 and 16 rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 3899588.

The reference teaches reacting water, magnesium hydroxide and valeric acid (saturated linear C₅) and magnesium hydroxide to form the organic acid magnesium salt in a ratio of 1:2. See column 3, line 57 and column 5, lines 9-35. The similar compounds produced would be expected to exhibit similar properties such as the ethanol solubility recited in instant claim 3.

Claims 1, 3, 10, 12, 13, 14 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5180850.

The reference example discloses the composition comprising about one mole valproic acid magnesium salt in a solvent system comprising about 400ml ethanol (300ml + 90g generated during the reaction, BP 78.3 C). While the reference differs in the manner in

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which the compounds are synthesized, a product-by-process claim is anticipated by a disclosure of the product itself. The similar compounds produced would be expected to exhibit similar properties such as the ethanol solubility recited in instant claim 3.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunsman
Primary Examiner
Art Unit 1755

DMB

A handwritten signature in black ink, appearing to be 'DMB', written in a cursive style.